2252-200.00

#6
2/11/03

PATENT
ATTORNEY DOCKET NO.: 051638-5001-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Scott A. SNYDER	Confirmation No.: 2465
U.S. Application No.: 09/580,448	Group Art Unit: 3624
Filed: May 30, 2000	Examiner: Narayanswamy Subramanian
For: A SYSTEM AND METHOD FOR ASSISTING CUSTOMERS IN CHOOSING A BUNDLED SET OF COMMODITIES USING CUSTOMER PREFERENCES	

Commissioner for Patents
Washington, D.C. 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

The Office Action dated January 6, 2003 (Paper No. 5) has been carefully reviewed. Reconsideration and withdrawal of the restriction requirement are respectfully requested in view of the remarks herein.

Election of Claim Group

In response to the Election/Restriction Requirement, requiring election under 35 U.S.C. § 121 between the claims of Group I (claims 1-45) and the claims of Group II (claims 46-53), Applicant hereby elects Group I (claims 1-45) for examination.

Traversal of Restriction Requirement

In issuing the restriction requirement, the Examiner states that the inventions are distinct because:

> Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has a separate process for choosing commodity options in that it does not require grouping steps described in the invention II claims. See MPEP 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

For a restriction requirement between two patentably distinct inventions to be proper, two criteria must exist: "(A) the inventions must be independent . . . or distinct as claimed . . .; and (B) there must be a serious burden on the examiner if restriction is required." MPEP 803. For at least the reason that the second criterion for a proper restriction, a serious burden on the examiner, has not been met, the restriction requirement should be withdrawn.

According to MPEP 808.02, once the related inventions are shown to be distinct, the examiner must show by appropriate explanation one of the following: (A) separate classification of the distinct inventions, (B) a separate status in the art when they are classifiable together, or (C) a different field of search. Category A does not apply – in the Office Action, the examiner classified both claim groups in class 705, subclass 36. The criteria for categories B and C have not been met; the examiner has made no showing that the subject matter of each claim group has achieved a separate status in the art or that a different field of search exists between the claim groups. Applicant notes that the definition of "a different field of search" requires "search[ing] for one of the distinct subjects in places where *no pertinent art to the other subject exists*." (MPEP 808.02 (emphasis added).) The examiner's conclusory statement that "the search

required for Group I is *not required* for Group II" (emphasis added) is insufficient for establishing the existence of a serious burden for restriction purposes.

In addition to the deficiencies outlined above with respect to the formal criteria for establishing a "serious burden," Applicant notes that the examiner has already examined all 53 claims in the first Office Action, lending credibility in fact to Applicant's position that no "serious burden" necessitating restriction exists. In view of the above remarks, Applicant respectfully requests withdrawal of the restriction requirement.

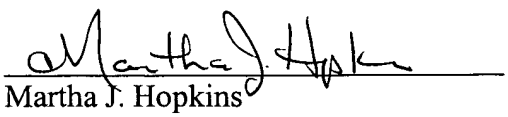
CONCLUSION

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested, and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: February 3, 2003

By: 
Martha J. Hopkins
Reg. No. 46,277

CUSTOMER NO.: 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Ave.
Washington, D.C. 20004
202-739-5198